

REMARKS

Applicant has studied the Office Action dated July 25, 2008. Claims 25-28, 35-39, and 45-51 are pending. Claim 35 has been amended to more clearly disclose the invention and claims 31-34 and 40-44 have been canceled without prejudice. New claims 50 and 51 have been added to claim the disclosed invention more completely. Claims 25, 35, 50, and 51 are independent claims. No new matter has been added as the amendments and the new claims have support in the specification as originally filed.

It is submitted that the application, as amended, is in condition for allowance. Reconsideration and reexamination are respectfully requested.

§ 112 Rejections

The Examiner rejected claims 40 and 45 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Specifically, the Examiner asserted that although claims 40 and 45 recite, "the terminal manipulation device is located on at least one lateral surface of the upper body," the specification and drawings do not disclose or suggest any terminal manipulation device that is located on a lateral surface of the upper body. Applicant respectfully disagrees with the Examiner's assertion.

With this paper, claim 40 has been canceled without prejudice. It is, therefore, respectfully submitted that the rejection is moot with respect to claim 40 and it is respectfully requested that the rejection be withdrawn.

Contrary to the Examiner's assertion, as indicated on page 11 of the response filed on April 21, 2008, it is noted that paragraph [0020] in the specification as originally filed recites that "one or more terminal manipulation devices 11 may also be located on lateral surfaces of the upper body 20 or the lower body 10." Therefore, it is respectfully submitted that support for these features recited in claim 45 can be found, for example, at paragraph [0020] in the specification. It is respectfully submitted that the grounds for the rejection have been overcome and it is respectfully requested that the Examiner withdraw the rejection.

§ 103 Rejections

Claims 31-39, 41, and 46 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shibata et al. ("Shibata" US 7,084,919) in view of Yoshida et al. ("Yoshida" US 6,690,417). This rejection is respectfully traversed.

It is respectfully noted that the Federal Circuit has provided that an Examiner must establish a case of prima facie obviousness. Otherwise the rejection is incorrect and must be overturned. As the court recently stated in In re Rijkaert, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993):

"In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. 'A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.' If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned." (citations omitted.)

It should be emphasized, in accordance with M.P.E.P. 2114, "apparatus claims must be structurally distinguishable from the prior art." *In re Danly*, 263 F. 2d 844, 847, 120 USPQ 528, 531 (CCPA 1959) it was held that apparatus claims must be distinguished from prior art in terms of structure rather than function. *In Hewlett-Packard Co. v Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990), the court held that: "Apparatus claims cover what a device is, not what it does" (emphasis in original). To emphasize the point further, the court added: "An invention need not operate differently than the prior art to be patentable, but need only be different" (emphasis in original).

With this paper, claims 31-34 and 41 have been canceled without prejudice. It is, therefore, respectfully submitted that the rejection is moot with respect to claims 31-34 and 41 and it is respectfully requested that the rejection be withdrawn.

With regard to the rejection of independent claim 35, it is respectfully noted that the Examiner asserts, at page 7 of the Office action, that Yoshida discloses a positioning mechanism providing optical zooming by causing relative motion between the lens and the image sensor responsive to user manipulation of the at least one terminal

manipulation device, citing col. 7, lines 26-34. Independent claim 35 has been amended to recite a zoom lens positionable relative to the camera and the positioning mechanism is operated by the controlling unit when the controlling unit receives a signal for the optical zooming through user manipulation of the at least one terminal manipulation device.

Review of the cited portion of Yoshida reveals that the lens 108 is a zoom lens of the three-time magnification, which is structured to shift the zooming positions manually. However, it is respectfully submitted that the cited portion of Yoshida is insufficient for disclosing that the positioning mechanism is operated by the controlling unit when the controlling unit receives a signal for the optical zooming through user manipulation of the at least one terminal manipulation device, as recited in independent claim 35. Therefore, it is respectfully submitted that Yoshida fails to disclose or suggest, at least, these features recited in independent claim 35. It is further respectfully submitted that Shibata fails to cure the above identified deficiencies of Yoshida with respect to independent claim 35.

In view of the above arguments, it is respectfully asserted that the Examiner has failed to establish a prima facie case of obviousness and, therefore, independent claim 35 is allowable over the cited combination of references, as are claims 36-39 and 46, which depend from claim 35.

Claims 42-44 and 47-49 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shibata in view of Yoshida and in further view of Ueda (US 4,847,647). This rejection is respectfully traversed.

With this paper, claims 42-44 have been canceled without prejudice. It is, therefore, respectfully submitted that the rejection is moot with respect to claims 42-44 and it is respectfully requested that the rejection be withdrawn.

As asserted above, independent claim 35 is allowable over Shibata and Yoshida. Moreover, it is respectfully submitted that Ueda fails to cure the above identified deficiencies of Shibata and Yoshida with respect to claim 35.

Therefore, it is respectfully asserted that independent claim 35 is allowable over the cited combination of references. It is further respectfully asserted that claims 47-49,

which depend from independent claim 35, also are allowable, at least, by virtue of their dependency from their respective base claims.

Allowable Subject Matter

Applicant graciously acknowledges the Examiner's allowance of claims 25-28.

New Claims

Claims 50 and 51 have been newly added. Support for claims 50 and 51 can be found, for example, at paragraphs [0025] and [0026] of the specification as originally filed. Accordingly, no new matter has been added.

It is respectfully noted that the Examiner asserts, at page 7 of the Office action, with regard to the rejection of independent claim 35, that Shibata in view of Yoshida discloses an inherent image sensor and a lens positioned relative to the image sensor, citing col. 10, lines 4-20 of Shibata.

It is respectfully noted that inherency cannot be established by mere possibilities or even probabilities. The fact that a certain result or characteristic may occur or be present in cited art is not sufficient to establish the inherency of that result or characteristic. (M.P.E.P. § 2112 IV)

It is respectfully noted that the Examiner fails to develop reasons supporting a reliance on inherency. Indeed, the Examiner merely asserts that an image sensor is inherently present in Shibata. Therefore, this mere conclusive statement cannot reasonably be said to be a development of any reason supporting the Examiner's reliance on inherency. Consequently, the asserted reliance on inherency is unsupported and thus improper.

Further, Applicant's review of the cited portion in Shibata reveals a first photographic lens 33 for a digital camera and a second photographic lens 23 for a TV telephone, a button 13 for taking an image, and a zoom button 11 in connection with the photographic function. However, it is respectfully submitted that there is no disclosure in Shibata implying or inherently disclosing the presence of the image sensor for automatic zoom focusing and a lens positionable relative to the image sensor, as recited in claims 50 and 51.

Furthermore, none of the cited references discloses or suggests the image sensor detecting a subject and measuring a distance between the subject and the photographic apparatus, as recited in independent claim 50, or the image sensor detecting a subject and measuring a distance between the subject and the photographing apparatus, and a controlling unit comparing the distance measured by the image sensor with a preset optimum distance and automatically performing optimal zooming according to a comparison result, as recited in independent claim 51. In view of the above discussion, it is believed that independent claims 50 and 51 are patentable over the cited references.


CONCLUSION

In light of the above remarks, Applicant submits that the present Amendment places all pending claims of the present application in condition for allowance. Reconsideration of the application is requested.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California telephone number (213) 623-2221 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,
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